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UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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JAN 5 2001

In re

DECISION ON
PETITION FOR REGRADE
UNDER 37 C.F.R. § 10.7(c)

MEMORANDUM AND ORDER

(petitioner) requests for regrading questions 17, 20 and 39 of the morning section and questions 10, 16 and 27 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On July 26, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioners' arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning questions 17, 20 and 39 and afternoon questions 10, 16 and 27. Petitioners' arguments for these questions are addressed individually below.

Morning question 17 reads as follows:

17. Smith invented a laminate. In a patent application, Smith most broadly disclosed the laminate as comprising a transparent protective layer in continuous, direct contact with a light-sensitive layer without any intermediate layer between the transparent protective layer and the light-sensitive layer. The prior art published two years before the effective filing date of Smith's application included a laminate containing a transparent protective layer and a light-sensitive layer held together by an intermediate adhesive layer. Which of the following is a proper claim that would overcome a 35 U.S.C. § 102 rejection based on the prior art?

- (A) 1. A laminate comprising a transparent protective layer and a light-sensitive layer.
- (B) 1. A laminate comprising a transparent protective layer and a light-sensitive layer which is in continuous and direct contact with the transparent protective layer.
- (C) 1. A laminate comprising a transparent protective layer and a light-sensitive layer, but not including an adhesive layer.
- (D) (A) and (B).
- (E) (B) and (C).

The model answer is choice is (E). Both claims (B) and (C) would overcome a 35 U.S.C. § 102 rejection based on the prior art.

Petitioner selected answer B. Petitioner argues that answer (E) is incorrect because claim (C) is improper. Petitioner argues that claim (C) is not a proper claim because it includes a negative limitation. Petitioner argues that any claim containing a negative limitation which does not have basis in the original limitation should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. Petitioner asserts that there is no mention of the negative limitation. Petitioner argues that claim (C) indefinite and would be rejected on the basis of aggregation. See MPEP 2173.05(k). Petitioner asserts that since claim (C) is incorrect and that answers (B) is correct that petitioner should be awarded credit.

Petitioners' arguments have been fully considered but they are not persuasive. Claim (B) overcomes a 35 U.S.C. § 102 rejection because the claim requires a light-sensitive layer to be in continuous and direct contact with the transparent protective layer, whereas the prior art

interposes an adhesive layer between the light-sensitive layer and transparent protective layer.

Claim (C) also avoids the prior art by using a negative limitation to particularly point out and distinctly claim that Smith does not claim a laminate including an adhesive layer. MPEP

2173.05(i). Thus, answer (D) is correct because both claims (B) and (C) are correct. While the limitation "but not including an adhesive layer" may lack literal basis in the specification that alone is insufficient to establish a *prima facie* case for lack of descriptive support. See MPEP

2173.05(i). In the instant case, the description describes "the laminate as comprising a transparent protective layer in continuous, direct contact with a light-sensitive layer without any intermediate layer between the transparent protective layer and the light-sensitive layer," thus there is no adhesive layer. The claims are not indefinite as an aggregation or a lack of cooperation between the elements, because the cooperation is known. The laminate comprises the transparent protective layer and the light sensitive layer, wherein one layer is upon the other.

Morning question 20 reads as follows:

20. In the course of prosecuting a patent application, you receive a final rejection wherein the examiner has set a 3 month shortened statutory period for reply. You file an initial reply with a Certificate of Mailing in accordance with 37 C.F.R. § 1.8 within 2 months of the final rejection mail date. The examiner responds with an Advisory Action having a mail date before the end of the 3 month shortened statutory period. In accordance with proper PTO practice and procedure, the fee for an extension of time for applicant to take subsequent appropriate action in the PTO is calculated from:

- (A) the mail date of the Advisory Action.
- (B) the date your reply is received by the PTO.
- (C) the date your reply is mailed with a Certificate of Mailing in accordance with 37 C. F. R. § 1.8.
- (D) the mail date of the Final Rejection.
- (E) the date the shortened statutory period expires.

The model answer is choice is (E). In accordance with proper PTO practice and procedure, the fee for an extension of time for applicant to take subsequent appropriate action in the PTO is calculated from the date the shortened statutory period expires.

Petitioner selected answer (B). Petitioner argues that answer (D) is correct. Petitioner argues that answer (E) is incorrect because the shortened statutory period could end on a holiday, such as July 4, however the response is not due until the next business day.

Petitioners' arguments have been fully considered but they are not persuasive. Petitioner selected answer (B), not (D) thus it is irrelevant whether or not answer (D) is a proper response. Answer (E) is correct because MPEP § 710.02(e), right column of page 700-83, recites, "[I]f applicant initially replies within 2 months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of 3 months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of 3 months from the date of mailing of the final rejection. In such a case, any extension fee would then be calculated from the end of the 3-month period."

Morning question 39 reads as follows:

39. Impermissible recapture in an application exists _____
- (A) if the limitation now being added in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.
 - (B) if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application.
 - (C) if the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

- (D) if the limitation now being omitted or broadened in the present reissue was being broadened for the first time more than two years after the issuance of the original patent.
- (E) None of the above.

The model answer is choice is (C). Impermissible recapture in an application exists if the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

Petitioner selected answer (E). Petitioner argues that answer C is incorrect because the statement in choice C does not allow a narrower claim. Petitioner argues that “a claim limitation that is **broadened** would thereby **narrow** the claim in comparison to the original and would therefore be permissible”. (*emphasis added*) Petitioner argues that if an original claim were deliberately canceled in the original application to make the claim allowable, when a narrowing limitation is added during reissue, the examiner must determine if the narrowing limitation narrows the original claim in a material respect and thus not impermissible recapture.

Petitioner’s arguments have been fully considered but they are not persuasive. Petitioner’s premise that “a claim limitation that is broadened would thereby narrow the claim in comparison to the original” claim is not persuasive. The current case law on the recapture rule is summarized in the MPEP 1412.02.

A reissue will not be granted to “recapture” claimed subject matter which was surrendered in an application to obtain the original patent. *Hester Industries, Inc. v. Stein, Inc.*, 142 F.2d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); *In re Richman*, 409 F.2d 269, 276, 161 USPQ 359, 363-364 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).

The recapture rule applies when the reissue claims are broadened based on subject matter surrendered in an application to obtain the original patent. According to the MPEP 1412.02, if the limitation now being omitted or broadened in the present reissue was originally presented/ argued/ stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists. Furthermore, if the reissue claim is broadened in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165. See MPEP 1412.02.

Afternoon question 10 reads as follows:

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client, Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley's patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner properly rejects independent claim 1 under 35 U.S.C. §§ 102 and 103 using the Russian reference and objects to the remaining claims as being dependent upon a rejected claim. Sam receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial problems and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

- (A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.
- (B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.
- (C) File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.
- (D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original

- reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.
- (E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

The model answer is choice (B), do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 are confirmed.

Petitioner selected answer (D). Petitioner argues that "this question is fatally flawed, and all answers should be accepted as correct." Petitioner argues that answer (B) is incorrect because further action is needed to make claims 2-10 allowable. Petitioner argues that since claim 1 is rejected and that dependent claims stand or fall with the claim upon which they depend that claims 2-10 are improper and not patentable.

Petitioner's arguments have been fully considered but they are not persuasive. If the attorney does nothing as stated in choice B, a Reexamination Certificate will issue confirming the patentability of dependent claims 2-10. See MPEP §§ 2287 and 2288. An amendment incorporating the limitations of independent claim 1 into the dependent claims 2-10 is not required. The claims have already been patented as this is a reexamination.

Afternoon question 16 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent

application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

- (A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.
- (B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.
- (C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.
- (D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice is (B). Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.

Petitioner selected answer (E). Petitioner argues that answer (B) is inconsistent with the examination guidelines in the MPEP. Petitioner argues that in neither *In re Merck & Co.*, nor *Newell Cos. V. Kenney Mfg.*, cited by the PTO in support of the answer (B) addresses simultaneous inventions and the level of skill in the art. Additionally, these cases are neither cited nor discussed in the MPEP for determining the level of ordinary skill in the art. Petitioner argues that neither the MPEP, nor case law recognizes nearly simultaneous invention as evidence of the level of skill in the art as a consideration of obviousness.

Petitioner's arguments have been fully considered but they are not persuasive. Answer B is correct because *In re Merck & Co.*, 231 USPQ 375, 380 (Fed. Cir. 1986) noted that "[t]he additional, although unnecessary, evidence of contemporaneous invention is probative of 'the level of knowledge in the art at the time the invention was made.' *In re Farrenkopf*, 713 F.2d 714, 720, 219 USPQ 1, 6 (Fed. Cir. 1983)." The fact that near simultaneous invention may be evidence of the level of skill in the art at the time of the invention is stated in *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 45 USPQ2d 1977, 1983 (Fed. Cir. 1998), "[t]his court has noted the relevance of contemporaneous independent invention to the level of ordinary knowledge or skill in the art," referring to *Merck*. Furthermore, *The International Glass Company, Inc. v. United States*, 159 USPQ 434, 442 (US Cl.Ct, 1968), states that "[t]he fact of near simultaneous invention, though not determinative of statutory obviousness, is strong evidence of what constitutes the level of ordinary skill in the art." Accordingly, nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.

Afternoon question 27 reads as follows:

27. A patent application is filed with the following original Claim 1:

A steam cooker comprising:

- (i) a steam generating chamber having a steam generator;
- (ii) a cooking chamber adjacent to said steam generating chamber for receiving steam from said steam; and
- (iii) a heat exchanger secured within said steam generator, said heat exchanger including at least one heating zone comprised of an inner having raised surface projections thereon, an outer panel having raised surface projections thereon, and a path between said raised surface projections whereby flue gases may pass for heating the walls of the heat exchanger.

Assuming all of the following amendments are supported by the original disclosure in the specification, which amendment is in accord with proper PTO amendment practice and procedure?

- (A) In Claim 1, line 4, after "steam" insert, --generator--.
- (B) In Claim 1, line 6, after "inner" insert --panel--.
- (C) In Claim 1, line 6, delete [one], insert --two--, and amend "zone" to read --zones--.
- (D) In Claim 1, line 3, after "chamber" (second occurrence) delete [for receiving] and insert --to produce sufficient quantities of gas and--.
- (E) In Claim 1, line 4, delete "secured within" and insert --attached to--.

The model answer is choice is (B), but (A) is acceptable. Both choices A and B are amendments in accord with proper PTO amendment practice and procedure.

Petitioner selected answer (E). Petitioner argues that since two answers are acceptable and that the directions state that there is one correct answer that the question is defective. Petitioner argues that since the question is defective, all answers should be given credit. Petitioner argues that since question 15 was deemed defective and all answers were given credit, the same should be done for this question.

Petitioner's arguments have been fully considered but they are not persuasive. The amendments in (A) and (B) each specifies the exact matter to be inserted, the exact point where the insertions are to be made, and each is limited to five words or less. The preamble is considered to be line 1 of the claim. See 37 C.F.R. § 1.121; MPEP § 714.22. Choice E is incorrect because it fails to identify the correct point where the deletion and insertion are to be made. The phrase "secured within" does not occur in line four of the claim and there is no instruction for the insertion of the phrase "attached to."

No error in grading has been shown as to morning questions 17, 20 and 39 and afternoon questions 10, 16 and 27. Petitioner's request for credit on these questions is denied. The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and*

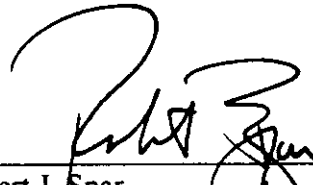
Trademark Office, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000)(The court held that the PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in grading and preclude[s] unfair and individually discriminatory grading." *Id.*, slip opinion at 5. The court concluded that "the decision of the Commissioner of the USPTO not to regrade Mr. Worley's examination answers as correct when the answers did not conform with the USPTO's Model Answers was not arbitrary and capricious." *Id.*, slip opinion at 5-6.)

ORDER

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy